

**Remarks**

1. In the office action dated February 4, 2003, the examiner provisionally rejected claims 1-29 based upon double patenting under 35 U.S.C. § 101 due to the co-pendency of parent application serial no. 09/903,778. In response, the applicant has filed a declaration of express abandonment of the prior parent application, U.S. application serial no. 09/903,778, a copy of the declaration is attached hereto as Exhibit 1. An express abandonment of the parent application will moot a double patenting rejection under 35 U.S.C. § 101. *See Application of Verne R. Rinehart*, 531 F.2d 1048 (U.S. Court of Customs and Patent Appeals, 1976).
2. The examiner found claims 19 and 21-23 to be allowable if they were rewritten to include all of the limitations of the base claim 1. Claims 19 and 21, above, have been rewritten in the manner prescribed by the examiner and are intended to replace the prior claims 19 and 21. Addendum sheet (page 7 hereto), showing marked up changes regarding claims 19, 21 and the original base claim 1 is attached. Claims 22 and 23 depend from the rewritten and now allowable claim 21, thereby making claims 22 and 23 a fortiori allowable.
3. In the instant office action, the examiner rejected claims 1-18, 20 and 24-29 under 35 USC § 102 and/or § 103. The applicant has directed the cancellation of these claims.
4. The new claims 30-49 are being presented for consideration. Independent claim 30 adds the limitation of placing the current stoppage means "connected aft of the conductive lead." Such placement of the current stoppage means eliminates any portion of the wire lead from picking up harmful inductive current (see page 10, second paragraph of specification). Billin, the cited prior art, discloses a transformer having a circuit breaker and does not speak to an electrode having the structural limitations of claim 30 (e.g. Billin discloses no leads, distal end, proximal end etc.) and therefore, Billin is not relevant. The Miller reference discloses an electrode with a short lead (col. 3, lines 24-30) extending between the current limiter and proximal end, and does not speak to the electrode of claim 30 where the current limiter/stoppage means is placed aft of the lead. Claim 31 is dependent on claim 30 and adds the further novel limitation of the current stoppage means being "coupled to the proximal end of the electrode." This limitation has

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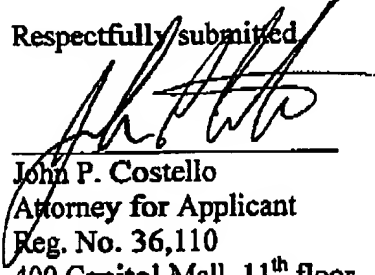
the proximal end and current stoppage means together as a unit. Neither the cited Billin or Miller references cite an electrode structure wherein the current limiter/stoppage means is combined with the proximal end. Billin is irrelevant to this issue as it teaches a transformer and Miller teaches an electrode with the current limiter and proximal end being separated by a wire lead (see Fig. 1 elements 11, 17 and 23 of Miller).

5. The additional new dependent claims which depend on claims 30 and 31 add additional novel features and thus are submitted to be afortiori patentable. Claims 33-36 depend from claim 30 and disclose the further novel limitations of a circuit breaker, a diode, a fuse and an indicator fuse, respectively, as alternative "current stoppage means." Claims 36-39 are dependent on claim 31 and disclose the further novel limitations of a circuit breaker, a diode, a fuse and an indicator fuse, respectively, as alternate "current stoppage means." Claims 40-45 depend from claim 30 and disclose the further novel limitations of a needle, a plate, a strap, a clip, an earplug and a contact lens, respectively, as alternate "proximal ends."
6. Independent claim 46 adds the novel limitation of a fuse to the inventive electrode to prevent the passage of harmful current. Miller teaches an electrode which uses a diode to prevent the passage of current, but does not teach the use of a fuse. Billin discusses the use of fuses generally with regard to medical appliance circuitry (col. 1, lines 30-35), but does not mention the use of fuses with a medical electrode. The applicant has already discussed the use of fuses in medical appliance circuitry ("Background" section at pages 3 and 5 of the written specification), and noted there that despite fusing in medical machines like that in Billin, nevertheless such medical machines can still be defective to the point that harmful current still passes to the electrodes. So far the art has failed to see the solution of placing a fuse on the electrode itself, which prevents the passage of harmful current from a defective machine which already has fused circuitry. Claim 47 adds the novel limitation of an indicator fuse. An indicator fuse would allow a medical technician to see at a glance if the fuse on an electrode has blown. This indication of a blown fuse would prompt the technician to investigate the cause, be it defective machinery or other cause, so that the problem can be traced and the potential for burns or electrocution avoided. Neither Miller or Billin teach the use of indicator fuses. Claims

- 48 and 49 adds novel ampere limitations (e. g. "approximately 1/16 amperes") to claims 47 and 46, respectively, these limitations not being taught in either Miller or Billin.
7. The undersigned, an attorney licensed to practice before the U.S. Patent Office, respectfully requests that the examiner find the present application in a condition for allowance, and that if there are any questions regarding this response that the examiner please contact the undersigned attorney at (916 ) 558-6107.

Date: March 25, 2003

Respectfully submitted

  
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ADDENDUM SHOWING MARKED-UP CHANGES TO CLAIMSBASE CLAIM 1:

1. A medical electrode for preventing the passage of harmful current to a patient, the electrode comprising:

a distal end for connecting to a medical device;

a proximal end for connecting to a patient;

a conductive lead connected between the distal and proximal ends; and

a current stoppage means connected to the electrode at a location for preventing the passage of harmful current to the proximal end.

19. [AMENDED] A medical electrode for preventing the passage of harmful current to a patient, the electrode comprising:

a distal end for connecting to a medical device;

a proximal end <sup>formed in the shape of a contact lens</sup> for connecting to a patient;

a conductive lead connected between the distal and proximal ends; and

a current stoppage means connected to the electrode at a location for preventing the passage of harmful current to the proximal end.

21. [AMENDED] A medical electrode for preventing the passage of harmful current to a patient, the electrode comprising:

a distal end for connecting to a medical device;

~~a proximal end for connecting to a patient;~~ <sup>a separable structure having first and second separable members, the separable structure being located at a proximal end of the electrode, the separable structure being positioned atop the second member, the second member having a surface for directly contacting a patient;</sup>

a conductive lead connected between the distal and proximal ends; and

a current stoppage means <sup>being connected to the second member so that when the first and second members are separated, the current stoppage means remains with the second member.</sup> connected to the electrode at a location for preventing the passage of harmful current to the proximal end.

# EXHIBIT 1

Practitioner's Docket No. 9721/9544

**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of:

Application No.: 09 / 903,778 Group No.: 3700

Filed: July 11, 2001 Examiner: David M. Ruddy

For: Medical Electrode for Preventing the Passage of Harmful Current to a Patient

Assistant Commissioner for Patents  
Washington, D.C. 20231

**EXPRESS ABANDONMENT OF APPLICATION (37 C.F.R. 1.138)**

This application is hereby expressly abandoned.

NOTE: An express abandonment must be signed by the applicant and the assignee of record, if any, or by the attorney of record. 37 C.F.R. § 1.138.

NOTE: "Express abandonment of the application may not be recognized by the Office unless it is actually received by the appropriate officials in time to act there before the date of issue." 37 C.F.R. 1.138.

NOTE: If the purpose of the express abandonment under 37 C.F.R. § 1.138(a), which does not require a payment of a fee, is to avoid publication of the application the danger is that if the written declaration of abandonment is not timely recognized, not only will there be publication, but there will be a non-revocable abandonment of the application.

**CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10\***

(When using Express Mail, the Express Mail label number is mandatory;  
Express Mail certification is optional.)

I hereby certify that, on the date shown below, this correspondence is being:

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37 C.F.R. § 1.8(a)

37 C.F.R. § 1.10 \*

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Signature

John P. Costello

(type or print name of person certifying)

\* Only the date of filing (§ 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under § 1.8 continues to be taken into account in determining timeliness. See § 1.703(f). Consider "Express Mail Post Office to Addressee" (§ 1.10) or facsimile transmission (§ 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

(Express Abandonment of Application [9-24]—page 1 of 2)

(complete the following applicable item(s))

**A. Inventors**

\_\_\_\_\_  
(type or print name of inventor)

\_\_\_\_\_  
Signature of inventor

(add similar information and signatures for all inventors)

**B. Assignee**

\_\_\_\_\_  
(type or print name of person authorized to sign on behalf of assignee)

\_\_\_\_\_  
Signature of person authorized to sign on behalf of assignee

\_\_\_\_\_  
(type name of assignee)

\_\_\_\_\_  
Address of assignee

\_\_\_\_\_  
Title of person authorized to sign on behalf of assignee

Assignment recorded in PTO on \_\_\_\_\_  
Reel \_\_\_\_\_ Frame \_\_\_\_\_

A "CERTIFICATE UNDER 37 C.F.R. 3.73(b)" is attached.

Reg. No.: 36,110

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\_\_\_\_\_  
SIGNATURE OF PRACTITIONER

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(Express Abandonment of Application [9-24]—page 2 of 2)